

Remarks

Claims 1, 3-5, 7, 9-11, 13-16, and 18-25 are pending in the present application and are rejected.]

Claims 2, 6, 8, 12 and 17 have been previously cancelled.

Claim 16 is cancelled.

Claims 10 and 19 are amended to incorporate the limitations of claim 16 – “wherein the composition has a moisture content of less than about 0.1 wt. %, as measured by total weight of the composition.”

Claims 19 and 21 are amended as set forth in the Examiner’s amendment dated November 29, 2005.

The present invention provides a concentrate for coloring a base polyester which includes one or more colorants and from about 20 wt. % to about 80 wt. % of one or more copolymers. The copolymers include one or more of olefin/acrylate copolymer or olefin/methacrylate copolymer. The present invention overcomes many of the problems in the prior art by specifically excluding low melt viscosity resins (such as waxes). Such problems include the premature melting at the feed throat, obstruction of resin flows, and excessive screw slippage (specification, p. 2, ll. 25-28). Moreover, the processing of two materials (i.e., the low viscosity resin and the copolymer) increases the process complexity (specification, p. 3, ll. 10-12). Finally, the concentrate of the present invention when combined with a base polyester provides a polyester composition having a **moisture content of less than about 0.1 wt. %** as measured by total weight of the polyester composition.

1. Rejection Under 35 U.S.C § 102(b)

Claims 10-11, 13-16, and 18-25 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 54129050.

Independent claims 10 and 19 are amended to include a limitation on the moisture content requiring that it be "less than about 0.1 wt. %, as measured by total weight of the composition." JP 54129050 does not disclose such a limitation. Independent claim 21 already includes this limitation regarding the moisture content. The Examiner attempts to include the missing limitation regarding moisture content with an inherency argument. However, the Examiner's inherency argument is clearly inopposite to the law regarding inherency. The Federal Circuit has consistently held that:

Before a reference can be found to disclose a feature by virtue of its inherency, one of ordinary skill in the art viewing the reference must understand that **the unmentioned feature at issue is necessarily present in the reference**. *Continental Can*, 948 F.2d at 1268-69, 20 USPQ 2d at 1749-50. The test of inherency is not satisfied by what a reference "may" teach. *Id.*, 20 USPQ 2d at 1749-50 ("Inherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.")

SGS-Thomson Microelectronics, Inc. v. International Rectifier Corp., 32 USPQ 2d 1496, 1503 (Fed. Cir.) (unpublished), cert. denied, 513 U.S. 1052 (1994) (emphasis added).

Application of inherency to imply a specific moisture content is inappropriate. Moisture like any component in a composition can take on virtually any value. Therefore, the requisite for inherency that the "unmentioned feature at issue is necessarily present in the reference" is not met.

Accordingly, claims 10-11, 13-16, and 18-25 are patentable under 35 U.S.C. 102(b) over JP 54129050.

Claims 1, 3, 10-11, 13, 18-22, and 24-25 are rejected under 35 U.S.C. 102(b) as being anticipated by EP 370424.

EP 370424 also does not disclose a composition with a moisture content less than "about 0.1 wt. %, as measured by total weight of the composition" as required by independent claims 1, 10, 19, and 21. Again, the Examiner attempts to provide the missing limitation by inherency. For the same reasons set forth above, application of inherency is inappropriate.

Accordingly, claims 1, 3, 10-11, 13, 18-22, and 24-25 are patentable under 35 U.S.C. 102(b) over EP 370424.

2. Rejection Under 35 U.S.C § 103(a)

Claims 1, 3-5, 7, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 54129050 in view of EP 370424.

Applicants respectfully traverse the Examiner's rejection under 35 U.S.C. 103(a) for similar reasons as set forth above. Neither the JP 54129050 reference nor the EP 370424 reference disclose a composition with a moisture content "less than about 0.1 wt. %" as required by independent claim 1. The inappropriateness of utilizing inherency (which is a 102 argument anyway) to supply this missing limitation is set forth above. Accordingly, claims 1, 3-5, 7, and 9 are patentable under 35 U.S.C. 103(a) over JP 54129050 in view of EP 370424.

S/N: 10/050,680
Reply to Office Action of June 8, 2004




Atty Dkt No. EACC 0118 PUSP

Conclusion

Applicants have made a genuine effort to respond to each of the Examiner's rejections in advancing the prosecution of this case. Applicants believe that all formal and substantive requirements for patentability have been met and that this case is in condition for allowance, which action is respectfully requested. If a telephone or video conference would help expedite allowance or resolve any additional questions, such a conference is invited at the Examiner's convenience.

Respectfully submitted,

Thomas Joseph Pecorini et al.

By 
James W. Proscia
Reg. No. 47,010
Attorney/Agent for Applicant

Date: October 24, 2005

BROOKS KUSHMAN P.C.
1000 Town Center, 22nd Floor
Southfield, MI 48075-1238
Phone: 248-358-4400
Fax: 248-358-3351